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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,269	01/27/2004	Debra Ann Merrill	0470-040032	7572
28289	7590	03/01/2007	EXAMINER	
THE WEBB LAW FIRM, P.C. 700 KOPPERS BUILDING 436 SEVENTH AVENUE PITTSBURGH, PA 15219			LILLING, HERBERT J	
			ART UNIT	PAPER NUMBER
			1657	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		03/01/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/765,269	MERRILL ET AL.
	Examiner HERBERT J. LILLING	Art Unit 1657

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 25 January 2007.
- 2a) This action is **FINAL**.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 17-36 is/are pending in the application.
  - 4a) Of the above claim(s) 17-32 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 33-36 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) 17-32 are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_

1. Receipt is acknowledged of an amendment filed January 25, 2007

2. Claims 17-36 remain pending in this application.

Claims 1-16 were previously cancelled.

Claims 33-36 are the only active claims pending in this application.

3. The rejection based on Blom et al., has been withdrawn in view of the persuasive arguments.

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

**Claim 33-36 stand rejected under 35 U.S.C. 112, first paragraph**, because the specification, while being enabling for the argued limitations as noted by the claims of the parent application US 6,692,933 as recited by claim 1:

“Method for producing a glutamine-rich gluten-free peptide preparation from gluten protein, comprising the steps of: a) enzymatically hydrolysing gluten using one or more proteases to obtain a hydrolysate; b) acidifying the hydrolysate to a pH between 4 and 5; and c) filtering the hydrolysate to obtain the glutamine-rich gluten-free peptide preparation as the filtrate.”,

does not reasonably provide enablement for the claimed steps as alleged in view of the same process steps have been employed in the art of record. Therefore, the specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and practice the invention commensurate in scope with these claims based on the allegations by Applicant.

The rejections as stated stand under first paragraph are proper since it is under the same paragraph under 35 U.S.C. 112.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 33-36 are rejected under 35 U.S.C. 102(e) as anticipated by

Auriol et al U.S. 5,554,508

Auriol et al teaches a hydrolysate of wheat by enzymatically hydrolyzing the wheat with a protease at a neutral or alkaline pH.

Auriol et al is considered to produce a product from the hydrolysis of wheat gluten with an enzyme (Alcalase) at an alkaline pH within the scope of the claimed inventions

**Example 2: Alcoholysis of Wheat Gluten Peptides**

The wheat gluten peptides were prepared by hydrolyzing gluten with subtilisin (Alcalase) at pH=8: the average molar mass of the water-soluble peptides determined according to the conditions described in Example 1 is 4200.

The product(s) obtained by the above reference is considered to be within the scope of the inventions in view of the following decisions:

It is well settled that if a reference reasonably teaches a product which is identical or substantially identical or are produced by identical or substantially identical process, the PTO can require an applicant to prove that the prior art products do not inherently possess the characteristics of his claimed product. A rationale given for shifting the burden of going forward to applicant is that the PTO does not possess the facilities to manufacture or to obtain and compare prior art products, see In re Brown, 459 F.2d 531, 535,173 USPQ 685, 688 (CCPA 1972); In re Best, 562 F.2d 1252, 1255,195 USPQ 430, 433-434 (CCPA 1977).

Applicant's arguments filed January 25, 2007 have been fully considered but they are not persuasive. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the reference since the process steps are the same and that Applicant has not demonstrated or argued persuasively that the reference product is not within the scope of the claimed product in view of the same process steps are employed.

In addition, Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty based on the instantly claimed process steps which are the same for the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show persuasively how the amendments avoid such reference.

6. **No claim is allowed.**

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Lilling whose telephone number is 571-272-0918 and Fax Number is **571-273-8300**, or SPE Jon Weber whose telephone number is 571-272-0925. Examiner can be reached Monday-Friday from about 7:30 A.M. to about 7:00 P.M. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

H.J.Lilling: HJL  
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Art Unit 1657  
February 25, 2007

  
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